



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,729	02/25/2004	Peter A. Rodriguez	S0720.10U	2737

29633 7590 06/27/2006

ROGERS TOWERS, P.A.
1301 RIVERPLACE BOULEVARD, SUITE 1500
JACKSONVILLE, FL 32207

EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,729	Applicant(s) RODRIGUEZ, PETER A.	
	Examiner Anish Desai	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-20 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The applicant's arguments in response to the Office action dated 12/21/05 have been fully considered.

1. Claims 1-9, 11-20, 22, and 30-33 are pending in this application. Claims 10, 21, and 23-29 are cancelled. Support for newly added claims is found in the drawings.
2. The 112 rejections are maintained.
3. The art rejections of Peacock (US Patent Application Publication 2003/0235687 A1) are maintained. The art rejections of Peacock (US 2003/0235687 A1) in view of Herman et al. (US 3,308,006) are maintained. The art rejections of Peacock (US Patent Application Publication 2003/0235687 A1) in view of Bartelmuss et al. (US 5,816,526) are moot because claims 10 and 21 are cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement substantially as set forth in 12/21/05 Office action. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The language of the claim 1 continues to be an issue of grammatically ambiguous language so as not to clearly and accurately convey the spatial relationship of plies. The recitation "co-planar plies...a plurality of individual aligned paper strips", it is not clear as to how the plies are joined to each other. The recitation "co-planar plies" can be interpreted as all of the plies in the same plane (i.e. co-planar). However, the specification (drawings) seems to show the plies substantially parallel to each other. Various interpretations are possible but do not seem within the scope of the disclosed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8, 11-19, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Peacock (US Patent Application Publication 2003/0235687 A1).

Peacock teaches a paper tape or strap that is used for cutting a continuous web or a paper and for binding bales of pulp from which paper is made (Paragraph 0003). Thus, peacock is concern with the packaging of bales of pulp. Regarding claims 1 and 12, the paper tape of Peacock's invention is formed from folding a paper web and utilizes a heat sensitive adhesive (Paragraph 0025) such that the adhesive covers the

inside surfaces of the folded paper tape and the adhesive is also applied to at least one outer surface of the paper tape (Paragraph 0009). Thus, each outer surface of the paper tape can be bonded to each other. Alternatively, Figure 2 of Peacock shows folded paper tape that is bonded at the joint 22. Further as shown in Figure 3, which illustrates a tri-fold operation in which two sides 31, 32 of a paper web 30 are folded down on a bottom side 33 of the paper web 30. This forms a first inside surface 34. The two sides 31, 32 and the bottom side 33 are substantially the same width, so as to decrease the width of the paper web 30 by two thirds. In one embodiment, the paper web has a width of 9 inches, so that the two sides 31, 32 and the bottom side 33 each have a width of 3 inches. In this embodiment, after the tri-fold operation the width of the paper web is 3 inches (0025). According to Peacock, any number of folding operations could be performed in a variety of different ways as is known by one skilled in the art (Paragraph 0022) and two or more paper webs can be used to form the folded paper tape (Paragraph 0025). Regarding claims 1 and 12, Figure 1 of Peacock shows more than one internal ply between the outer surfaces of the folded paper tape of Peacock. The outer surfaces of the paper tape of Peacock reads on the external surfaces as claimed in the claimed subject matter.

With respect to claims 2 and 13, Figure 1 of Peacock shows more than one internal ply and the disclosure of Peacock at paragraph 0009 that adhesive covers the inside surfaces of the tape reads on claims 2 and 13.

Regarding claims 3 and 14, Peacock teaches polyvinyl alcohol as an adhesive. Polyvinyl alcohol is inherently water-soluble.

With respect to claims 4 and 15, the adhesive of Peacock is a heat sensitive adhesive (Paragraph 0024).

With respect to claims 5 and 16, according to Peacock, bale strapping tape utilized for bailing paper pulp is thoroughly re-pulpable (Paragraph 0006).

Regarding claims 6-8 and 17-19, at paragraphs [0022] and [0025], Peacock teaches that any number of folding operations could be performed in a variety of different ways as is known by one skilled in the art and other folds could be used as known to those skilled in the art and more or less fold could be performed. Additionally, at paragraph [0025], Peacock teaches that two or more paper webs can be used to form the folded paper tape.

With respect to claims 11 and 22, the water-soluble adhesive of Peacock will inherently be absorbed into the outer surfaces of the adhesive paper tape of Peacock.

Therefore, it is the examiner's position that Peacock anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock (US Patent Application Publication 2003/0235687 A1) as applied to claims 1 and 12 above, further in view of Herman et al. (US 3,308,006).

The invention of Peacock is previously disclosed. Peacock is silent as to teaching a corrugated internal support strip. However, Herman et al. teach an application of corrugated paperboards in the packaging industry. At column 1, lines 16-29, Herman et al. teach that in construction of corrugated paperboard, a corrugated sheet made from pulp is bonded to one or more monoplanar sheets (liners). Figure 2 of Herman et al. shows such a construction. According to Herman et al., the corrugated sheet (medium) of the paperboard functions to greatly enhance the strength of the finished paperboard (Column 1, lines 26-29). Note that the folded paper tape of Peacock has to be strong enough to be used in paper pulp bailing applications (See Paragraph 0011). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a corrugated internal ply/plies in the invention of Peacock, motivated by the desire to enhance the strength of the paper tape so that it can be used in the paper pulp bailing.

7. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock (US Patent Application Publication 2003/0235687 A1).

The invention of Peacock is previously disclosed. Peacock is silent as to teaching of paper strips are longitudinally folded approximately in half (claims 30 and 32), and paper strips are longitudinally folded approximately in thirds (claims 31 and 33). However, Peacock teaches that any number of folding operations could be performed (0022) and other folds could be used as known to those skilled in the art and more or less folds could be performed (0025). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to longitudinally fold

Art Unit: 1771

the paper web of Peacock in half and in thirds, motivated by the desire to provide a folded tape.

Response to Arguments

8. Applicant's arguments filed on 04/10/06 have been fully considered but they are not persuasive.

The applicant argues that Peacock does not disclose the use of plural paper strips to form the plies and the language pointed out by the Examiner in paragraph 0025 does not disclose separate strips as claimed in the application at hand. The examiner respectfully disagrees. Peacock clearly teaches in paragraph 0025 that "Two or more paper webs could be used to form the folded tape." Paper webs of Peacock are equated to the paper strips of the applicant. Likewise, it is clearly apparent that Peacock discloses separate strips as presently claimed. Accordingly the art rejections are sustained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD



**HAI VO
PRIMARY EXAMINER**